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09/534,470

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Kenneth A. Parulski

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EXAMINER

BLACKMAN, ROCHELLE ANN J

ART UNIT

PAPER NUMBER

2851

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/534,470	Applicant(s) PARULSKI, KENNETH A.	
	Examiner Rochelle Blackman	Art Unit 2851	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2000.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 04/17/00 .                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

New corrected drawings are required in this application because the drawings contain informal corrections. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Objections***

Claims 19 and 20 are objected to because of the following informalities: claim 19 recites the limitation "configured camera" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 20 falls with its parent claim, 19.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 and 23-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiota et al., U.S. Patent No. 6,324,521.

Regarding claims 1-6, Shiota discloses a “method for configuring a photographic film product and purchasing such configured photographic film product” and a “photographic film product configured according to the method”(see Figs. 1-8), comprising the steps of: (a) “providing an electronic database of information describing at least one photographic film product that can be configured by a purchaser via a digital communications network”(see 33 of FIG. 6); (b) “displaying at the purchaser's location remote from the electronic database information describing instructions to enable the purchaser to configure the at least one photographic film product”(see 30 of FIG. 6); (c) “the purchaser uploading at least one digital image from the purchaser's location remote from the electronic database”(see 20, 22a, 24a, 31, and 32 of FIG. 6) ; (d) “the purchaser providing a payment identifier specifying an account to be debited to pay for the configured photographic film product”(see PAYMENT METHOD in Fig. 2 and col. 9, lines 28-40);(e) “configuring the photograph film product to include the uploaded digital image; wherein the photographic film product includes film which is pre-exposed with the uploaded digital image; and (f) sending the configured photographic film product to a designee of the purchaser”(see col. 10, line 65 to col. 11, line 3); “further including the step of making a hard copy of the uploaded digital image, and utilizing such hard copy in the packaging of the configured photographic film product; and wherein the hard copy of the uploaded digital image is in the form of a printed label

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which is attached to the configured photographic film product”(see col. 11, lines 29-33); a “computer program product having instructions stored thereon for performing the method”(see col. 10, lines 42-48).

Regarding claims 7-16, 19, 20, and 23-36, Shiota discloses a “method for configuring a photographic film product and corresponding services and purchasing such configured photographic film product and services” and a “photographic film product configured according to the method”(see Figs. 1-8), comprising the steps of: (a) “providing an electronic database of information describing at least one photographic film product and corresponding services that can be selected by the customer via a digital communications network”(see 33 of FIG. 6); (b) “displaying at the customer's location remote from the electronic database the various services corresponding to the at least one photographic film product that can be selected by the customer”(see 30 of FIG. 6); (c) “the customer selecting desired services and providing a payment identifier specifying an account to be debited to pay for the photographic film product and the selected services”(see PAYMENT METHOD in FIG. 2 and col. 9, lines 28-40); (d) “configuring the photographic film product to indicate the selected services purchased by the customer; wherein the photographic film product includes at least one magnetic track, and wherein the selected services are recorded on the at least one magnetic track; wherein the customer selected services include the service provider storing the captured image on a digital media selected by the customer, and shipping the digital media to a designee of the customer and wherein the digital media is a CD-R; wherein the configuring step includes providing, on the photographic film product, an identifier

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designating to a services file indicating the selected services purchased by the customer; wherein the identifier is a bar code; wherein the photographic film product includes at least one magnetic track, and wherein the identifier is recorded on the at least one magnetic track; wherein the services file identifies the size of the hard copy print produced from the captured image; and (e) sending the photographic film product to a designee of the customer”(see col. 10, line 65 to col. 11, line 3); “capturing an image using the photographic film product; and (g) forwarding such photographic film product including the captured image to a service provider” and (f) capturing an image using the photographic film product; (g) forwarding such photographic film product including the captured image to a service provider; wherein the photographic film product includes film, and the services file identifies that the film should be optically printed; and (h) producing a hard copy print of the captured image”(see 122 of FIG. 8 and col. 7, lines 6-8 and see col. 11, lines 29-33); “wherein the customer selected services include the service provider storing the captured image on an Internet accessible digital storage device and wherein the customer selected services include the service provider e-mailing the captured image to at least one e-mail address provided by the customer; further including the step of sending the digital image file to an e-mail address identified in the services file; further including the step of storing the digital image tile on an Internet accessible digital storage device”(see col. 4, lines 43-47); “wherein the customer selected services include producing a hard copy print of the captured image”(see col. 11, lines 29-33); a “computer program product having instructions stored thereon for performing the method”(see col. 10, lines 42-48); “wherein

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the services file identifies a template to be combined with the captured image to produce the hard copy print; wherein the services file provides personal digital data to be printed on the hard copy print; wherein the personal digital data is printed on the back of the hard copy print”(see 20 of FIG. 6); “further including the step of digitally processing the captured image to provide a modified image and producing a hard copy print of the modified image; and wherein the services file identifies the type of digital processing to be performed”(see col. 2, lines 33-42 and see 20 of FIG. 6); “further including the steps of: (f) capturing an image using the photographic film product’, (g) forwarding such photographic film product including the captured image to a service provider; and (h) providing a digital image file from the captured image; and further including the steps of: (f) capturing an image using the photographic film product; (g) forwarding such photographic film product including the captured image to a service provider; and (h) producing a hard copy print of the captured image, wherein the selected services recorded on the at least one magnetic track identify the type of hard copy print to be produced; wherein the selected services recorded on the at least one magnetic track further identify a template to be combined with the captured image to produce the hard copy print; and wherein the selected services recorded on the at least one magnetic track further provides personal digital data to be printed on the hard copy print”(see 122 of FIG. 8, col. 7, lines 6-8; col. 10, line 65 to col. 11, line 3; and col. 11, lines 29-33).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick, U.S. Patent No. 5,696,965 in view of Arnold U.S. Patent No. 5,758,216.

Dedrick discloses the claimed invention including purchasing a camera by an end user from an advertiser on an electronic information distribution system through a network, where advertiser 18 may create an advertisement for a camera which describes the camera in both audio and video format and an end user would define a search criteria for appraisal agent 28 to find an advertisement(s) for a camera which meets the end user's needs, such as a particular brand, features, price, etc. (see col. 4, lines 28-30 col. 7, lines 16-26, and col. 8, lines 19-24 and FIG. 1-6).

Dedrick however, does not disclose a purchaser "uploading at least one digital image from the purchaser's location remote from the electronic database" and "configuring the camera to include the uploaded digital image".

Arnold discloses a pre-recorded MOF layer information processing system that pre-records information into dedicated tracks of the filmstrip MOF layer specific to a particular special promotion accompanying the purchase of the film cartridge in a single use camera which can be read out by a photofinisher when processing the filmstrip and completing a customers order and the camera having an external package displaying



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the particular special promotion along with instructional information visible to camera user (see col. 3, lines 50-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the camera of the Dedrick reference with pre-recorded information related to a particular promotion on the filmstrip of the film cartridge in the camera along with an external display of the particular promotion, as taught by Arnold in order to allow an advertiser to provide an end user or purchaser with pertinent advertisement information, such as promotional information and instructional information, on the camera and/or film of the camera, in addition to providing the pertinent advertisement information of the camera to the end user or purchaser in an audio or visual format, thereby facilitating comprehension or providing a reminder of the pertinent advertisement information related to the camera when the end user or purchaser receives the camera.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rochelle Blackman whose telephone number is (571) 272-2113. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell Adams can be reached on (571) 272-2851. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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